

REMARKS

Claims 1-40 and 42-137 are pending in the subject application. Portions of claims 1-17, 20, 32, 33, 35-39, 42-45, 47, 68-72, 74, 77, 87-90, and all of claims 18, 19, 21-31, 34, 46, 48-67, 73, 75, 76, 79-86, and 91-136, have been withdrawn from further consideration under 37 C.F.R. § 1.142(b) as constituting allegedly patentably distinct inventions.

Before addressing the merits of the Office Action, applicants wish to thank the Examiner for affording the undersigned attorney the courtesy of an interview on June 24, 1998.

In their previous Amendment dated November 7, 1997, applicants elected a single species for examination purposes, i.e. the compound of claim 137, (3R,4S,5S)-3-(1,4-dimethoxy-naphthalen-2-ylmethoxy)-4-[4-[3-(2-methoxy-benzyloxy)-propoxy]-phenyl]-piperidin-5-ol. The subject Office Action responds to applicants' November 7, 1997 Amendment and identifies a "generic concept" which was created by the Patent Office to encompass applicants' claimed species.

It is applicants' position that the Patent Office does not have the legal authority to create a "generic concept" and require applicants to limit a particular claim to the subject matter indicated as being allowable, i.e. claim 1 as limited to embrace the generic concept.

The Patent Office has failed to follow both its own internal procedures as set forth in the MPEP and the law in making the restriction requirement and withdrawing the mentioned claims from consideration. Accordingly, applicants traverse the Patent Office's withdrawal of the mentioned claims from consideration and request reconsideration of the restriction requirement made in the Office Action.

Procedures for making an election of species are described in MPEP 809.02. Applicants made a species election in response to this Office Action. As set forth in MPEP 809.02, the Patent Office is required to perform a search for all claims readable on the elected species, including applicants' claim 1 in the present situation. The MPEP does not authorize the Patent Office to derive "a generic concept as depicted in claim 1" to be carved out of existing claims. Therefore, the Patent Office has not followed its own internal procedures.

Applicants have the right under U.S. patent law to claim their invention using the limitations that they regard as essential to delineate the invention, as long as the requirements of 35 U.S.C. §112 are met. As is clearly pointed out in MPEP §803.02,

"[s]ince the decision in-- (*In re Weber*, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 198 USPQ 334 (CCPA)) it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention, *In re Harnish*, 206 USPQ 300 (CCPA 1980) and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). Broadly, unity of invention exists where compounds included

within a Markush group (1) share a common utility and (2) share a substantial structural feature disclosed as being essential to that utility."

No rejection was made in the present case under the judicially created doctrine of improper Markush. The restriction requirement in the present application was made solely under 35 U.S.C. §121. It is well established law that **restriction within a single claim cannot be sustained under 35 U.S.C. §121**. As is stated in *In re Weber*, at pages 331-332,

"§121 provides the Commissioner with the authority to promulgate rules designed to *restrict an application* to one of several claimed inventions when those inventions are found to be "independent and distinct." It is not, however, provide a basis for the Examiner acting under the authority of the Commissioner to *reject* a particular *claim* on that same basis." (Emphasis in original text.)

In the subject application, the Patent Office made the exact type of restriction requirement expressly forbidden by the CCPA in *In re Weber*. There is no basis under 35 U.S.C. §121 to restrict claim 1 and the subsequent generic claims encompassing the species of claim 137 in the manner set forth by the Patent Office.

Withdrawal of applicants' claims, and in particular claim 1, from further consideration due to an intraclaim restriction requirement amounts in fact to a rejection, see *In re Hass*, 179 USPQ 623, 625 (CCPA 1973). Thus, applicants would be entitled

to appeal to the Board of Patent Appeals and Interferences in the event the Examiner were to make the restriction requirement final. This proposition is upheld in *In re Weber* at 332.

As in *In re Hass*, the claims in the present application are being withdrawn from consideration not only in this application but prospectively in any subsequent application because of their content. As the Patent Office's "generic concept" is constructed, it would be impossible for applicants to garner in subsequent patent applications the remainder of the claims after the "generic concept" is cleaved out, especially with regard to the written description requirement. *In re Weber* at 331 states

If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on the merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the sub-genera would be defined by the examiner rather than the applicant, it is not inconceivable that a number of the fragments would not be described by the specification.

In view of the above, applicants request that the restriction requirement be withdrawn. In particular, applicants request that the intra-claim restriction requirements be withdrawn since such restriction is prohibited both under the law and under Patent Office policy as set forth in the MPEP.

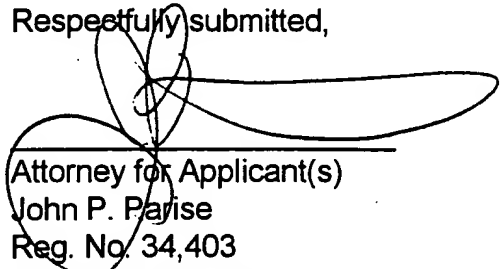
For the reasons stated above, applicants request reconsideration of the restriction requirement as provided for under 37 CFR §1.143.

On Form PTO 1449 considered by the Examiner on February 5, 1998, it was noted that documents A2 and A3 were not considered because copies were not provided. Applicants enclose copies of these documents for consideration.

If a telephone conference would be of assistance in furthering prosecution of the subject application, applicants' undersigned attorney requests that he be contacted at the number provided below.

No fee, except the fee for a one-month extension of time, is required in connection with the filing of this Communication. If any fee is deemed necessary, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 08-2525.

Respectfully submitted,



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FORM PTO-1449

U.S. Department of Commerce
Patent and Trademark OfficeAtty. Docket No.
4019/135Serial No.
08/711,339**LIST OF INFORMATION CITED BY APPLICANT**
(Use several sheets if necessary)Applicant
Binggeli et al.Filing Date
September 6, 1996Group
1613**U.S. PATENT DOCUMENTS**

* EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
	A2	5,378,712	01/03/95	Alig et al.			
	A3	5,545,658	08/13/96	Alig et al.			

FOREIGN PATENT DOCUMENTS

		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION	
							YES	NO

OTHER ART (Including Author, Title, Date, Pertinent Pages, Etc.)

EXAMINER

DATE CONSIDERED

*EXAMINER Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.